

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Claims 56-63 remain pending and have been amended.

PERSONAL INTERVIEW

Applicants appreciate the opportunity granted their representative to conduct a personal interview with Mr. Tran (SPE) on February 22, 2007. As indicated in the Interview Summary, the teachings of Fujinami (U.S. Patent 5,455,684) were discussed, with Applicants' representative presenting patentability arguments consistent with those contained in the Reply dated October 11, 2006. The outstanding double patenting rejections and the rejection of "storage medium" claims under 35 U.S.C. § 101 were also discussed. An agreement was reached that certain claim amendments would overcome the prior art rejections based on Fujinami. Mr. Tran indicated that double patenting rejections would also be withdrawn, but that the rejection under 35 U.S.C. § 101 would be maintained.

In this Reply, Applicants have amended the claims in a manner that is believed to be consistent with the suggested claim amendments discussed during the Personal Interview. Applicants note with respect to claim 61 that the phrase "position information" has been changed to "picture arrangement information," and submit that this change does not negatively affect the patentability of claim 61 with respect to the cited prior art.

Applicants respectfully submit that the prior art rejection (35 U.S.C. § 102) and the double patenting rejections should be withdrawn. Furthermore, Applicants have amended claims 56, 60 and 61, such that these claims are no longer directed to a "storage medium." Therefore, the rejection under 35 U.S.C. § 101 has been rendered moot.

REJECTION UNDER 35 U.S.C. §101

Claims 56, 60 and 61 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As set forth on pages 17-18 of the Office Action, the Examiner asserts that claims 56, 60 and 61 merely claim non-functional descriptive material stored on a medium, and, as such, fail to claim statutory subject matter. Although Applicants believe that these claims are directed to statutory subject matter at least for reasons contained in the Reply dated October 11, 2006, Applicants have amended claims 56, 60 and 61, such that these claims are no longer directed to a "storage medium." Therefore, the rejection under 35 U.S.C. § 101 has been rendered moot.

In review of the above, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. §101.

REJECTION UNDER 35 U.S.C. §102

Claim 56-63 stand rejected under 35 U.S.C. §102 as allegedly being anticipated by Fujinami et al. (U.S. Pat. No. 5,455,684). This rejection is respectfully traversed.

Fujinami discloses a video/audio recording apparatus for recording encoded video/audio on a digital storage medium (DSM)10. The recording apparatus receives encoded video data compressed in accordance with the MPEG coding standard, such that the compressed video signal includes I, P, and B coded pictures. See eg., col. 6, lines 60-67; col. 12, lines 28-31. A header addition circuit 7, in cooperation with a control circuit 8, adds a video packet header to the video signal and an entry packet generation circuit 32 inserts an entry packet at a predetermined position in the video signal. Col. 11, lines 52-63. An entry packet is positioned to precede a video packet consisting of a video packet header and a portion of the video signal that includes an I-picture. Col. 12, lines 19-24. Each entry pack includes information regarding distances between the current entry point and positions of proceeding and subsequent entry points, thereby enabling a high-speed search operation upon playing back from the DSM 10. Col. 13, lines 4-9; col. 19, lines 39-45.

Thus, the entry packet information in Fujinami is used to indicate entry points for a video packet that includes a I-picture but does not provide a control information, which precedes I-picture data of a corresponding video data unit, containing control information that includes: address information of P-picture data in a video data unit as required by claim 56; address information of I-picture data and P-picture data in a video data unit as required by claim 59; or

picture arrangement information of I-picture, P-picture data, and B-picture data in a video data unit as required by claim 61.

According to MPEP § 2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claims.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

At least in view of the above, Applicants respectfully submit that Fujinami fails to anticipate claim 56, claim 59 or claim 61. The remaining claims are believed to define of Fujinami based on similar reasoning.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the Examiners rejection under 35 U.S.C. §102.

DOUBLE PATENTING REJECTIONS

1. U.S. Patent No. 6,009,236/U.S. Patent No. 6,134,382/Co-Pending Application No. 10/083,267 in View of Fujinami.

Claims 56-63 stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Pat. No. 6,009,236 (“the ‘236 patent”) in view of Fujinami; further stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S Pat. No. 6,134,382 (“the ‘382 patent”) in view of Fujinami; and further stand provisionally rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of co-pending application no. 10/083,267 (“the ‘267 application”) in view of Fujinami. These rejections are respectfully traversed.

In rejecting claims 56-63 based on the allegedly obvious combination of ‘236 patent claims and Fujinami, the Examiner relies on Fujinami as allegedly teaching the feature of a control data packet that includes control information including address information of I-picture data and P-picture data in a video data unit. See Office Action, page 5. For reasons discussed

above with respect to the rejection under 35 U.S.C. §102, however, Applicants submit that Fujinami fails to teach the control information as claimed. At least for this reason, the asserted combination of claims of the '236 patent and Fujinami fails to establish obviousness of any pending claim.

Similarly, the Examiners rejection of claims 56-63 based on an allegedly obvious combination of '382 patent claims and Fujinami relies on Fujinami as allegedly teaching the control information as claimed. See Office Action, pages 8-9. As Fujinami fails to teach this claim feature, Applicants respectfully submit that the asserted combination of claims of the '382 patent and Fujinami fails to establish obviousness of any pending claim.

With respect to the rejection of claims 56-63 based on an allegedly obvious combination of the '267 application claims and Fujinami, the Examiner again relies on Fujinami as allegedly teaching control information including address information of I-picture data and P-picture data in the video unit. See Office Action, pages 13-14. As Fujinami fails to teach the control information as claimed, Applicants respectfully submit that the asserted combination of '267 application claims and Fujinami fails to establish obviousness of any pending claim.

2. U.S. Pat. No. 6,549,717.

Claims 56-63 stand rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Pat. No. 6,549,717. This rejection is respectfully traversed.

With respect to claim 2 of U.S. Pat. 6,549,717 ("the '717 patent"), the Examiner relies on claim 2 as allegedly being encompassed by claims of the present application. Applicants note, however, that claim 2 of the '717 patent fails to include the feature of control information as claimed. As such, Applicants respectfully disagree with the Examiner's conclusion that claim 2 of the '717 patent is encompassed by the scope of any claim pending in the present application. Consequently, Applicants respectfully submit that claims in the present application are not rendered obviousness based on the claim 2 of the '717 patent. In view of the above, Applicants respectfully request reconsideration and withdrawal of the provisional and non-provisional rejections based on the doctrine of obviousness-double patenting.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact D. Richard Anderson, Reg. No. 40,439 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: **March 29, 2007**

Respectfully submitted,

By 

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